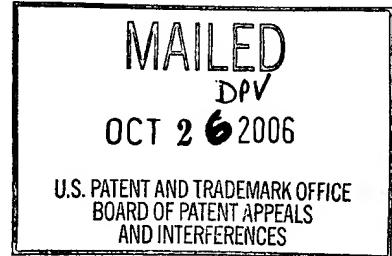


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE BURNS



Application No. 09/182,033

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on August 10, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the

application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

BACKGROUND

On November 18, 2002, the Board of Patent Appeals and Interferences (Board) rendered a decision in the instant application (Appeal No. 2002-1664), in which the Board Affirmed-In-Part, the Examiner's Final Rejection mailed May 9, 2001. In the Board's decision, the Board (1) reversed the rejection of claims 30-49 under 35 U.S.C. § 112, first paragraph, (2) affirmed the Examiner's rejection of claims 30-37, 39-47 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Nichtberger (U.S. Patent 4,882,675) in view of De Lapa (U.S. Patent 5,822,675), and (3) reversed the Examiner's rejection of claims 38 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Nichtberger in view of De Lapa.

On June 3, 2003, the examiner reopened prosecution of the application without the Technology Center (TC) Director's approval. On August 6, 2003, Appellant's representative, Mr. Christopher B. Kilner (Reg. No. 45,381), participated in a telephonic interview with the Examiner. During this interview, Mr. Kilner pointed out that the TC Director had to approve the reopening of prosecution.

The TC Director approved the reopening of prosecution in the Office Action mailed August 6, 2003. In the Office Action mailed August 6, 2003, the Examiner rejected claims 38 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Nichtberger in view of De Lapa and further in view of Christensen (U.S. Patent 6,035,280).

On November 6, 2003, Appellant filed a response to the reopening of prosecution, amending claims 30 and 40 and arguing that the claims as amended are patentable over the prior art of record. In response to this amendment, the Examiner mailed a Notice of Non-Compliant Amendment on November 9, 2003. On November 14, 2003, appellant refiled the amendment in the proper format.

On January 27, 2004, the Examiner entered the amendment to claims 30 and 40 and mailed a Final Rejection. In the Final Rejection the Examiner did not address claims 30-37, 39-47, and 49.

On March 29, 2004, Appellant filed an Appeal Brief. Appellant argued in the Appeal Brief that the Examiner attempted to withdraw claims 30-37, 39-47 and 49 from consideration, leaving claims 38 and 48 the only active claims in the application. Appellant argued that the withdrawal of claims 30-37, 39-47 and 49 is erroneous, since the claims were amended.

On April 20, 2006, the Examiner mailed an Examiner's Answer, stating that the only grounds of rejection was the rejection of claims 38 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Nichtberger in view of De Lapa and further in view of Christensen (U.S. Patent 6,035,280), and that all arguments pertaining to claims 30-37, 39-47 and 49 are moot since the Board affirmed the Examiner's rejection.

On June 6, 2006, Appellant filed a Reply Brief setting forth that the claims on appeal were claims 30-49, not claims 38 and 48, since the Examiner entered the amendment dated November 14, 2003. Further, Appellant argued that since the Examiner had not made a specific rejection of claims 30-37, 39-47, and 49, that the Examiner has withdrawn the rejection of these claims.

On July 27, 2006, the Examiner mailed an acknowledgment of receipt and consideration of the Reply Brief filed June 6, 2006. The communication further advised appellant that the case was forwarded to the Board of Patent Appeals and Interferences.

DEFICIENCIES OF THE RECORD

The first deficiency noted in this case is that the Examiner inappropriately informed Appellant, in the Office Action mailed August 6, 2003, that to avoid abandonment Appellant must exercise one of the following options:

“(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or
(2) request reinstatement of the appeal.”

It should be noted to Appellant and the Examiner, that the Board rendered a decision on November 18, 2002, thus there is no reinstatement of that appeal (Appeal No. 2002-1664). For Appellant to proceed to a new appeal, he needs to file a new Notice of Appeal, a new Appeal Brief, as well as submission of the appropriate Notice of Appeal and Appeal Brief fees. See the Manual of Patent Examining Procedure, (MPEP) §1214.01.

The second deficiency, there is a question as what claims are on appeal. The Examiner, by entering the amendment dated November 14, 2003, to claims 30 and 40 permitted Appellant to change the claims. Accordingly, the Examiner now needs to deal with the amended claims.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner for:

- 1) a proper determination and resolution of which claims are on appeal including, if appropriate, to reopen prosecution;
- 2) Appellant thereafter, if appropriate, to file a new Notice of Appeal and fee;
- 3) Appellant also, if appropriate, to file a new Appeal Brief and fee;
- 4) vacating, if appropriate, the Examiner's Answer of April 20, 2006, and issuing an new Examiner's Answer responsive to any newly filed Appeal Brief, and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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DMS/dpv

Application 09/182,033

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